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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,469	01/18/2006	Thilo Dollase	101769-310-WCG	3249
27386 7590 04/20/2009 NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
04/20/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/537,469

**Applicant(s)**

DOLLASE ET AL.

**Examiner**

VICTOR S. CHANG

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6 and 8-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. Applicants' amendments and remarks filed on 3/6/2009 have been entered. Claim 1 has been amended. Claims 1, 2, 4-6 and 8-15 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

### ***Rejections Based on Prior Art***

4. Claims 1, 2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-025460 [machine translation], and evidenced by applicants' admission.

JP '460 relates to an acrylic pressure-sensitive adhesive composition. The composition comprises block copolymer represented by the formula  $(A-B)_a-A$ , wherein A is a vinyl (co)polymer, B is a (co)polymer of a 1-12C alkyl (meth)acrylate, and  $a = 1$  to 10. For example, an A-B-A block copolymer obtained by copolymerizing n-butyl acrylate polymer blocks with methyl methacrylate block [abstract]. The adhesive can be used to form a pressure sensitive adhesive sheet, etc., on one side or both sides of a base material, such as paper, etc. [0058 and 0060]. The binder (adhesive) layer can be hot melt coated by an extruder onto the base material [0059].

For claims 1, 2 and 8, JP '460 is silent about the glass transition temperatures, the immiscibility of the polymer blocks, and the adhesiveness of the polymer blocks. However, since applicants have admitted that useful monomers of block P(A) include acrylic esters with alkyl groups having 4 to 14 carbon atoms (e.g., n-butyl acrylate), etc. [specification, page 15], and useful monomers of block P(B) include methyl methacrylate, etc. [specification, page 16], and further admitted that the amounts of monomers and their ratios, etc., are result effective [Remarks page 8], JP '460 anticipates the chemistry of the claimed invention. The glass transition temperatures, the immiscibility, and adhesiveness of the polymer blocks of the A-B-A block copolymer (n-butyl acrylate polymer blocks and methyl methacrylate polymer block) of the claimed invention are deemed to be inherent properties to the same chemistry.

5. Claims 4, 5, 6 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-025460 [machine translation], and evidenced by applicants' admission.

The teachings of prior art are again relied upon as set forth above.

For claims 4, 5 and 10, JP '460 is silent about the use of release layer and adhesion promoting primer layer. However, absence of any evidence to the contrary, the Official notice "these layers are common and well known" has been taken as admitted prior art. It would have been obvious to one of ordinary skill in the art to incorporate that layers in adhesive sheets formed from the adhesives of JP '460, motivated by the desire to improve the release property of individual adhesive sheets from a multilayered adhesive pad; and to enhance the adhesion between the adhesive layer and support, respectively.

For claims 6 and 12-15, JP '460 is silent about providing the pressure sensitive adhesive sheet in the form of a pad of plurality of adhesive sheets. However, absence of any evidence to

the contrary, the Official notice “providing a plurality of adhesive sheets in the form of a pad of conveniently predetermined size is common and well known” has been taken as admitted prior art.

For claim 9, since JP ‘460 teaches the same chemistry of the binder (adhesive) composition, forming the layer by the same melt extrusion process [see specification page 9, line 34], and for the same end use as the claimed invention, workable refractive indices of the block copolymers are deemed to be either anticipated, or obviously provided by practicing the invention of prior art for the same end use.

For claim 11, selecting a commercially acceptable color for the paper support of an adhesive sheet product is deemed to be obviously provided by practicing the prior art for the same end uses.

### ***Response to Arguments***

6. Applicants argue at Remarks pages 6-7:

“Nothing in the JP reference teaches or suggests an adhesive which, when coated on a substrate, forms a coating that has regions which are non-adhesive as well as regions which are adhesive. In particular, there is absolutely no hint in the JP reference which would lead those skilled in the art to choose monomers which are immiscible with each other. By contrast, the JP reference is concerned with obtaining a strong adhesive, and this would lead those skilled in the art away from the use of Applicants’ inner softener aspect, even if those reading the JP reference were aware of such a concept.”

However, the adhesiveness of the polymer blocks of the A-B-A block copolymer (n-butyl acrylate polymer blocks and methyl methacrylate polymer block) of the claimed invention are deemed to be inherent properties to the same chemistry anticipated by JP ‘460. It is unseen how JP ‘460 teaches away from the same chemistry.

Applicants argue at page 7:

“The adhesives of the JP reference would not be useful for sticky pads, because they, or the sheets of paper from the sticky pads made with them, would adhere to paper too strongly to be useful as note sheets that are easily removable from the papers to which they are attached, without harm.”

However, absence of any evidence, applicants’ analysis in vacuum ignores the fact that JP ‘460 teaches the same adhesive composition as the claimed invention.

Applicants argue at page 8:

“For claims 6 and 12-15, the Examiner contends that providing a plurality of adhesive sheets in the form of a pad of conveniently predetermined size is common and well known. The Examiner has not provided any evidence whatsoever to support this contention, however.”

However, to adequately traverse an Official notice, Applicant must specifically point out the *supposed errors* in the Examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. See MPEP § 2144.03.C.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794